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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET-NO.	CONFIRMATION NO.
09/872,293	05/31/2001	G. Eric Engstrom	112076-138338	2368

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,293

Applicant(s)

ENGSTROM, G. ERIC

Examiner

Marissa Thein

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ME

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The drawing or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's "Amendment and Response" filed August 27, 2004 has been considered.

Applicant's response by virtue of amendment to claim 1 has not overcome the Examiner's rejections of such claim under 35 USC 101.

Claims 1 and 9 are amended. Claims 1-29 remain pending in this application.

Response to Arguments

Applicant's arguments filed on August 27, 2004 have been fully considered but they are not persuasive.

Applicant remarks that "O'Donnell does not teach providing the substitute delivery address to the subscriber".

The Examiner notes that O'Donnell teaches "providing the substitute delivery address to the subscriber". In paragraph 171, O'Donnell discloses a user computer 20 which transmit and receives data and/or information from the shipper computers 40 and third party shipper computers 60. The user computer contains databases which include shipping information, subscription information, subscriber information (paragraph 177). In paragraph 198, the shipper computer 40 can also transmit and receive data and/or information from the user computers 20. The shipper computer includes databases which contain any information and/or data for decoding, decrypting and/or deciphering any labels and/or shipping information (paragraph 206). Furthermore, the shipper computer includes databases which contains data and/or information pertaining to any

users (subscriber) (paragraph 199). The database can include any data and/or information needed and/or desired for performing any other functions and/or services (paragraph 199). Moreover, the shipper computer also contains any information being stored in the respective databases of the central processing computers, the user computers, etc. (paragraph 210). Such user computer (subscriber) receiving data or information from the shipper computer (delivery address service) pertaining to shipping information are considered the providing to the subscriber a substitute address.

Applicant remarks that "O'Donnell does not teach having the delivery address service received notification of a request or receipt of goods".

The Examiner notes that O'Donnell does teach "the delivery address service received notification of a request or receipt of goods". In paragraph 198, the shipper (delivery address service) computer 40 can transmit and receive data and/or information from the provider computers, central processing computers, user computers, financial institution computers, and third party shipper computers. The shipper computer contains databases which contain transaction information which includes activity dates, transaction dates, goods, products, items, and/or services purchased (paragraph 203). Such transaction information containing the activity dates, transaction dates, goods, products, items, and/or services purchased are considered the delivery address service receiving notification of a request or receipt of goods.

Applicant remarks that "Yamada does not teach or otherwise suggest that a delivery address service provides a subscriber with a substitute delivery address, and

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be equipped to receive and response to a notification of a delivery request or receipt of a purchased goods".

The Examiner notes that O'Donnell was cited for the delivery address service provides a subscriber with a substitute delivery address, and to receive and response to a notification of a delivery request, as discussed above. Yamada was cited for the mailboxes and the mailbox proximately located with the mailing address of the subscriber.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-14 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. For instance claim 1, the steps of "receiving by the delivery address service, an electronic subscription....."; ".....electronically providing the subscriber....."; "receiving by the delivery address service, an electronic notification....."; and "intervening by the delivery address service" could all be performed manually by a person. There is no structural or functional interrelationship with these method steps. Therefore, the claim is directed towards non-statutory subject matter. The other claims above are similarly rejected. To overcome this rejection the Examiner recommends the Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such

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as --receiving by the delivery address service via computer network, an electronic

subscription from a subscriber, the received subscription including a mailing address of the subscriber--. See MPEP 2106 IV 2(b)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 7-8, 10-16, 19-23, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al.

Regarding claims 1, 15, and 22, Andrews discloses an electronic delivery address service method, storage medium and an apparatus comprising:

- the receiving by the delivery address service, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber (see at least paragraphs 11-12; 26; 92; 108; 125-127; 130; 132);
- the electronically providing the subscriber with a substitute delivery address (see at least paragraphs 29; 55; 108; 139; 158);
- the receiving by the delivery address service an electronic notification of either a request to deliver or an arrival of a purchased goods, as a result of the substitute

delivery address being used in an online purchaser of the goods (see at least paragraphs 11-12; 26; 37; 87); and

- the intervening by the delivery address service to facilitate delivery of the purchased goods to the subscriber, using the provided mailing address of the subscriber (see at least see at least paragraphs 11-12; 26; 87-88; 92; 108; 125-127; 130; 139).

Regarding claims 2, 16, and 23, O'Donnell discloses the correlation of the substitute delivery address to the mailing address of the subscriber (see at least paragraphs 29; 55; 139).

Regarding claims 7-8, 19-20, and 26-27, O'Donnell discloses wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially created by the delivery address service (see at least abstract; paragraphs 139; 158); the receiving of a notification of a request to deliver a purchased good from a delivery service, and the providing the mailing address of the subscriber to the delivery deliver service (see at least paragraphs 17; 134-135; 158; 265).

Regarding claims 10-12, 21, and 28, O'Donnell discloses the receiving a confirmation by the deliver address service of the purchase (see at least paragraph 33; 71; 137; 264); wherein the delivery address service receives the confirmation form the subscriber (see at least paragraph 33; 71; 137; 264); and receives the confirmation from an online business from which the goods to be delivered was purchased (see at least paragraph 33; 71; 137; 264).

Regarding claims 13-14, O'Donnell discloses the subscriber is a purchaser of the goods; or a beneficiary of the purchaser (see at least paragraph 90).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 17-18, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. in view of U.S. Patent Application No. 6,336,100 to Yamada.

O'Donnell substantially discloses the claimed invention, however, it does not explicitly disclose the mailboxes and the mailbox proximately located with the mailing address of the subscriber. O'Donnell discloses the method and apparatus for providing anonymous shipping services (paragraph 2). O'Donnell discloses the apparatus includes one or more shipping service provider computer and one or more third party shipping service provider computers (paragraphs 17 and 19). The shipper can be carrier, delivery service provider, shipping service provider, and transporter (paragraph 92). The third party shipper can be third party carrier, third party shipping service provider, third party delivery service provider, etc (paragraph 94). Furthermore, O'Donnell discloses tracking information which include name of shipping party and address information, name of receiving party and the address information, etc.

~~-(paragraph 202). Yamada, on the other hand, teaches the mailboxes and the mailbox~~

proximately located with the mailing address of subscriber (col. 1, lines 11-15; col. 1, lines 22-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, storage medium for executing instructions, and apparatus of O'Donnell, to include the mailbox the mailbox proximately located with the mailing address of subscriber, as taught by Yamada, so as to provide a place that is most convenient for the customer (col. 6, lines 10-31).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. O'Donnell substantially discloses the claimed invention, specifically, the delivery address service providing the mailing address of the subscriber to the delivery service (see at least paragraphs 265-267).

However, it does not explicitly disclose the automatically providing of the mailing address of the subscriber to the delivery address. It was known at the time of the invention that merely providing an automatic means of providing the mailing address to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In other words there is no enhancement found in the claim recited. The end result is the same as compared to the manual activity.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to automatically provide the mailing address without requiring the delivery address service to explicitly request since it has generally been recognized that

merely providing an automatic means to replace a manual activity which accomplishes the same request is not sufficient to distinguish over the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
November 29, 2004

Michael Cuff 11/29/04

**MICHAEL CUFF
PRIMARY EXAMINER**